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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,550	10/23/2001	Clifford Lardin		7661

7590 06/30/2005
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EXAMINER	
CHEA, PHILIP J	
ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,550

Applicant(s)

LARDIN ET AL.

Examiner

Philip J. Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to an Amendment filed April 9, 2005. Claims 1-34 have been cancelled. Claims 35-68 are currently pending of which claims 35-68 are new. Any rejection not set forth below has been over come by the current Amendment.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 44 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claim recites the limitation of a portable messaging unit, which could mean any portable messaging unit, not just the one claimed by the invention. In this situation, the invention has no control over the communication capabilities of a third parties portable messaging unit. A third party portable messaging unit could have the ability to transmit data a number of different ways and not just require the data transfer to be conducted via the claimed data exchange with said messaging node. There must be some indication that these portable messaging nodes are bound to work only with the messaging nodes of the claimed invention. The Examiner interprets the claim to mean that the portable messaging unit can only send and receive messages through the messaging node.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 35-44 and 60-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 35 mentions the limitation of establishing a temporary physical connection in lines 7 and 8. It is unclear what the scope of the limitation "temporary" means.
6. Claim 60 mentions the limitation of establishing a temporary physical connection in line 7. It is unclear what the scope of the limitation "temporary" means.
7. All other claims not mentioned specifically are rejected by virtue of being dependent on a rejected claim.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 45,48-51,53,56,59,60,63-65 are rejected under 35 U.S.C. 102(b) as being anticipated by Ulrich (US 6,052,735).

As per claim 45, Ulrich discloses a method for the delivery of an incoming message in a messaging system comprising a plurality of messaging nodes (see column 14, lines 39-44), a plurality of user accounts with distinct messaging address identifiers (see column 16, lines 27-33), and a plurality of portable messaging units with firmware for controlling messaging operations (see column 7, lines 52-60), said method comprising the steps of:

a) proactively buffering incoming messages at a messaging node for a user account prior to the transport of a portable messaging unit associated with said user account to the immediate proximity of said messaging node (see column 11, lines 59-63);

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b) transporting said portable messaging unit associated with said user account to the immediate proximity of said messaging node (see column 5, lines 4-14);

c) delivering incoming messages for said user account from said messaging node to said portable messaging unit (see column 11, lines 59-63);

d) storing said incoming message within said portable messaging unit; whereby incoming messages are delivered to said portable messaging unit with firmware for controlling messaging operations (see column 15, lines 18-49).

As per claim 48, Ulrich further discloses a central server, and further comprising the step of requesting incoming messages for said user account by said messaging node from said central server (see column 12, lines 2-5, i.e. a mail server will send the electronic mail to the destination and column 6, lines 23-35).

As per claim 49, Ulrich further discloses that the data exchange is conducted via photonic communications means (see column 5, lines 1-14).

As per claim 50, Ulrich further discloses that the data exchange is conducted via supersonic communications means (see column 5, lines 1-14).

As per claim 51, Ulrich further discloses that the data exchange is conducted via a temporary data cable (see column 5, lines 1-14).

As per claim 53, Ulrich further discloses that the incoming message comprises a text message (see column 4, lines 20-25).

As per claim 56, Ulrich further discloses that the step of physically transporting said portable messaging unit to the immediate proximity of said messaging node further comprises establishing a physical connection at a messaging node docking port (see column 5, lines 1-14, where connection via a serial cable implies establishing a physical connection).

As per claim 59, Ulrich further discloses that proactively buffered messages are delivered from said messaging node to said portable messaging unit while said messaging node is disconnected from communications with the rest of said messaging system (see column 11, lines 52-63, where objects can

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be stored in object store without being connected to a messaging system if the object store was already received prior to the disconnection of the messaging system).

As per claim 60, Ulrich discloses a method for the delivery of an outgoing message in a messaging system comprising a plurality of messaging nodes (see column 14, lines 39-44), a plurality of user accounts with distinct message address identifiers (see column 16, lines 27-33), and a plurality of portable messaging units with firmware controlling messaging operations (see column 7, lines 52-60), said method comprising the steps of:

a) composing said outgoing message on a portable messaging unit while disconnected from all messaging nodes (see column 11, lines 64-67);

b) storing said outgoing message within said portable messaging unit while disconnected from all messaging nodes (see column 11, lines 64-67);

c) establishing a temporary physical connection between said portable messaging unit and a messaging node at a docking port subsequent to the storage of said outgoing message within said portable messaging unit (see column 5, lines 4-7);

d) delivering said outgoing message within said messaging node (see column 12, lines 1-2);

f) relaying said outgoing message from said messaging node to a delivery address, whereby outgoing messages are composed and sent from a portable messaging unit with firmware for controlling messaging operations (see column 12, lines 2-7, where an address is implied with the sending of an email and column 15, lines 18-50).

As per claim 63, Ulrich further discloses that the delivery of said outgoing message from said portable messaging unit to said messaging node is conducted via photonic communications means within said docking port (see column 5, lines 1-14).

As per claim 64, Ulrich further discloses that the delivery of said outgoing message from said portable messaging unit to said messaging node is conducted via supersonic communications means within said docking port (see column 5, lines 1-14).

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As per claim 65, Ulrich further discloses that said outgoing message comprises a text message (see column 4, lines 20-25).

Claim Rejections - 35 USC § 103

1. Claims 35,36,38-41,44,57,58,61,66-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich et al. (US 6,052,735), herein referred to as Ulrich, and further in view of Miller et al. (US 5,195,183), herein referred to as Miller.

As per claim 35, Ulrich discloses a messaging system means comprising a plurality of messaging nodes (see column 14, lines 39-44), a plurality of user accounts with distinct messaging address identifiers (see column 16, lines 27-33), and a plurality of portable messaging units (see column 7, lines 40-44) including

- a) storage means for firmware for controlling messaging operations (see column 7, lines 52-60);
- b) storage means for the storage of messages (see column 8, lines 59-66);
- c) composition means for the composition of messages (see column 7, lines 31-40);
- d) display means for the display of messages (see column 7, lines 31-40);
- f) docking means for establishing a temporary physical connection at any of a plurality of docking ports between a messaging node and a portable messaging unit (see column 5, lines 4-7); and
- g) communications means for conducting a data exchange between said messaging node and said portable messaging units may conduct two-way messaging via said messaging system when in physical contact with a messaging node of said messaging system (see Fig. 5, where H/PC [3] is temporarily connected using serial communications to Desktop [4]; and two-way messaging is considered sending and receiving email to other portable units that are synchronized with their respective messaging nodes, see claim 8, lines 24-25), and conduct user interface functions while disconnected from all messaging nodes and out of communications with all messaging nodes (see column 9, lines 10-14 and lines 21-29, where applications such as email can be used separately from the synchronization process).

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Although the system disclosed by Ulrich shows substantial features of the claimed invention (discussed above), it fails to disclose each messaging node including a plurality of separate docking ports; a plurality of user accounts with distinct messaging address identifiers; associative means for associating at least one of said portable messaging units with at least one of said user accounts.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Ulrich, as evidenced by Miller.

In an analogous art, Miller discloses portable data devices that can be coupled with a local area network at any of a multiplicity of points (see Abstract). Further teaching a plurality of messaging nodes each including a plurality of separate docking ports (see Fig. 6 for plurality of separate docking ports); and associative means for associating at least one of said portable messaging units with at least one of said user accounts (see column 20, lines 49-57).

Given the teaching of Miller, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ulrich by employing a plurality of separate docking ports and associating the portable messaging units with user accounts, such as disclosed by Miller, in order to synchronize more than one portable messaging unit at a time while synchronizing the appropriate portable messaging unit with the appropriate account.

As per claim 36, Ulrich in view of Miller further disclose a microswitch means for detecting the physical connection of said messaging node and said portable messaging unit within said docking port for initiating said data exchange (see Miller Fig. 3).

As per claim 38, Ulrich in view of Miller further disclose that the data exchange is conducted via photonic communications means with said docking port (see Ulrich column 5, lines 1-14).

As per claim 39, Ulrich in view of Miller further disclose that the data exchange is conducted via supersonic communications means within said docking port (see Ulrich column 5, lines 1-14).

As per claim 40, Ulrich in view of Miller further disclose that the data exchange is conducted via a temporary data cable within said docking port 9 (see Ulrich column 5, lines 1-14).

As per claim 41, Ulrich in view of Miller further disclose that the messaging system further comprises a central server gateway for all messaging traffic between said portable messaging units and

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the Internet (see Ulrich column 12, lines 2-5, i.e. a mail server will send the electronic mail to the destination and column 6, lines 23-35).

As per claim 44, Ulrich in view of Miller further disclose that the transfer of data between a portable messaging unit and any other type of electronic device requires that said transfer of data be conducted via said data exchange with said messaging node (see Ulrich column 4, lines 60-67 and column 5, lines 1-14).

As per claims 57,61,67, Ulrich in view of Miller further disclose that communications between said messaging node and said portable messaging unit, including the identification of a user account and the delivery of messages, are triggered by a further step of detecting a microswitch closure within said docking port indicating the commencement of said physical connection (see Miller Fig. 6, and column 8, lines 42-54).

As per claim 58,68, Ulrich in view of Miller further disclose that establishing a physical connection at a messaging node docking port includes the physical insertion of said portable messaging unit into a recessed space within the physical structure of said messaging node (see Miller Fig. 6).

As per claim 66, Ulrich in view of Miller disclose a method for the transfer of data between a portable messaging unit and a messaging node, where said messaging node

a) detects insertion of a portable messaging unit into a docking port within said messaging node (see Miller column 8, lines 42-54);

b) automatically enters a data exchange with said portable messaging unit (see Ulrich column 15, lines 28-50);

c) identifies at least one user account associated with said portable messaging unit (see Ulrich column 16, lines 27-33);

d) triggers the delivery of outgoing messages, composed before said insertion of said portable messaging unit into said docking port, from said portable messaging node (see Ulrich column 11, lines 64-67 and column 12, lines 1-5);

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e) identifies incoming messages addressed to user accounts associated with said portable messaging unit (see Ulrich column 11, lines 59-63);

f) delivers said incoming messages to said portable messaging unit (see Ulrich column 11, lines 59-63), within a messaging system comprising a plurality of messaging nodes (see Ulrich column 14, lines 39-44) and a plurality of portable messaging units with firmware for controlling messaging operations (see Ulrich column 7, lines 40-60).

2. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich in view of Miller as applied to claim 35 above, and further in view of Kikinis et al. (US 5,522,089), herein referred to as Kikinis.

Although the system disclosed by Ulrich in view of Miller shows substantial features of the claimed invention (discussed above), it fails to disclose that user interface functions of said portable messaging unit, including the composition and viewing of messages, are disabled while said portable messaging unit is in said docking port.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Ulrich in view of Miller, as evidenced by Kikinis.

In an analogous art, Kikinis discloses a personal digital assistant module with a local CPU that forms a host/satellite combination with a host computer having a docking bay, further showing that user interface functions of the portable messaging unit, including the composition and viewing of messages, are disabled while the portable messaging unit is in the docking port (see column 2, lines 23-33, where the user interface is implicitly disabled because the CPU of the PDA is disabled, therefore no CPU is available to run the PDA interface).

Given the teaching of Kikinis, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ulrich in view of Miller by disabling the interface of a PDA by disabling the CPU once the PDA is docked, such as disclosed by Kikinis, in order to allow a host computer to directly access the software and data stored on the PDA.

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3. Claims 42,43, rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich in view of Miller as applied to claim 35 above, and further in view of Stewart

As per claim 42, although the system disclosed by Ulrich in view of Miller shows substantial features of the claimed invention (discussed above), it fails to disclose a central server with means for tracking and billing messaging traffic between said portable messaging units via said messaging nodes.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Ulrich in view of Miller, as evidenced by Stewart.

In an analogous art, Stewart discloses a geographic based communications service system with a mobile unit able to communicate with multiple access points, further disclosing a central server with means for tracking and billing messaging traffic between mobile units (see column 5, lines 9-23).

Given the teaching of Stewart, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ulrich in view of Miller by employing a central server to bill and track messages, such as disclosed by Stewart, in order to allow a user to access their messages when away from home and pay for the services of accessing their messages.

As per claim 43, Ulrich in view of Miller in view of Stewart further disclose that the messaging nodes are geographically distributed in locations accessible to the public (see Stewart column 6, lines 11-29).

4. Claims 46,47,62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich as applied to claim 45 above, and further in view of Stewart (US 5,969,678).

As per claim 46, although the system disclosed by Ulrich shows substantial features of the claimed invention (discussed above), it fails to disclose a step of verifying that said user account has sufficient credit to receive incoming messaging traffic before said incoming message is delivered to said portable messaging unit.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Ulrich, as evidenced by Stewart.

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In an analogous art, Stewart discloses a geographic based communications service system with a mobile unit able to communicate with multiple access points, further disclosing a verifying that a user account has sufficient credit to receive incoming messaging traffic before said incoming message is delivered to said portable messaging unit (see column 5, lines 9-23).

Given the teaching of Stewart, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ulrich by verifying that a user has enough credit to receive incoming messages, such as disclosed by Stewart, in order to allow a user to access their messages when away from home and make sure the user pays for the services before receiving their message.

As per claim 47, Ulrich in view of Stewart further disclose that the messaging system further comprises a central server, and verification of said sufficient credit is performed by said central server (see Stewart column 5, lines 9-23).

As per claim 62, Ulrich in view of Stewart further disclose a central server verifying that said user account has sufficient credit to send outgoing messaging traffic before said outgoing message is relayed by said messaging node (see Stewart column 5, lines 9-23).

5. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich as applied to claim 45 above, and further in view of Extended Systems ("IrDA versus Bluetooth: A Complementary Comparison").

Although the system disclosed by Ulrich shows substantial features of the claimed invention (discussed above), it fails to disclose low power radio transceiver equipment, with communications range under 100 meters.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Ulrich, as evidenced by Extended Systems.

In an analogous art, Extended Systems discloses that it would have been obvious to use a communications means that is capable of a range under 100 meters (see page 2, "What is Bluetooth?").

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Given the teaching of Extended Systems, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ulrich by employing a communications means capable of a range under 100 meters, such as disclosed by Extended Systems, in order to transmit data when the device is brought within a range instead of taking the device out and pointing it at something (see Extended Systems page 4, paragraph 2).

6. Claims 54,55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich as applied to claim 45 above, and further in view of Pashley et al. (US 5,978,833).

Although the system disclosed by Ulrich shows substantial features of the claimed invention (discussed above), it fails to disclose an automated response to an outgoing message previously sent from said user account, where said outgoing message was a request for advanced network functions.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Ulrich, as evidenced by Pashley et al.

In an analogous art, Pashley et al. disclose an automated response to an outgoing message previously sent from a user account (see column 2, lines 25-40).

Given the teaching of Pashley et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ulrich by employing retrieval of advanced network functions, such as disclosed by Pashley et al., in order to view internet pages while on the go (see Pashley column 2, lines 41-48).

As per claim 55, Ulrich in view of Pashley further disclose that the advanced network functions comprise network webpage retrieval (see Pashley column 2, lines 41-48).

Response to Arguments

7. Applicant's arguments with respect to claims 35-68 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J. Chea whose telephone number is 571-272-3951. The examiner can normally be reached on M-F 7:00-4:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip J Chea
Examiner
Art Unit 2153

PJC 6/22/05

Bradley Edelman
Art Unit 2153